

REMARKS

Status Of The Claims

The Office Action dated July 2, 2003 has been reviewed, and its contents carefully considered. Claims 1-20 are pending. Claims 1-20 have been rejected. Claims 21 and 22 have been added. Claims 1, 3, 12, 17 and 18 have been amended.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Office Action

Claims 1-13 and 15-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Gurne et al. Without conceding the propriety of the rejection independent claims 1, 12 and 17 have been amended. It is respectfully submitted that Gurne et al. does not teach the invention that is presently claimed.

Regarding claim 1, the present invention recites a method of displaying automotive service data including, *inter alia*, “displaying a list of performance measurements...scrolling through said list of measurements...selecting a measurement...displaying a graphical representation of said selected measurement over time...and arranging the order in which said measurement descriptions and values are displayed in said displaying step.” Gurne et al. discloses an automotive diagnostic service tool which utilizes a hand held unit 10 for communicating with various controllers located on a car 12. The Examiner states that Gurne et al. teach arranging the order in which measurement descriptions and values are displayed in a measuring step. However, upon further review of Gurne et al., the description in column 16, lines 35-41 merely discloses that certain parameters of the data recorder in display mode may be

displayed graphically while the remainder of other parameters may be displayed textually. Thus, an operator may choose which data may be displayed and how, *i.e.*, graphically or textually, however, there is no teaching of “arranging the order in which said measurement, descriptions and values are displayed in said displaying step” as recited in claim 1 of the present invention.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, Gurne et al. cannot be said to anticipate the present invention as claimed. Thus, withdrawal of the rejection is respectfully requested.

Claims 2-11 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Independent claim 12 of the present invention recites, *inter alia*, an apparatus for displaying automotive service data comprising “a display screen...a pair of switches...a selection switch...a graphics program for generating a first graphical representation...said graphics program further producing a second graphical representation” wherein the graphics program simultaneously displays “a first graphical representation and a second graphical representation on said display screen.” It is respectfully submitted that Gurne et al. does not teach these combined features as recited in claim 12 of the present invention. At best, Gurne et al. teaches a display screen on a hand held unit 10 which is capable of graphically displaying certain automotive parameters as shown for instance in FIG. 12. The hand held unit of Gurne et al., however, does not teach a graphics program for generating and simultaneously displaying a

first graphical representation of selected data over time and a second graphical representation as recited, for instance, in claim 12 of the present invention. Hence, since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, Gurne et al. cannot be said to anticipate the present invention as claimed. Thus, withdrawal of the rejection is respectfully requested.

Claims 13, 15 and 16 ultimately depend from independent claim 12 and are patentable over the cited prior art for at least the same reasons as is claim 12.

Claim 17 of the present invention recites, *inter alia*, an apparatus for displaying automotive service data comprising “display means for displaying a list of engine performance status...selection means for selecting at least one of said engine performance measurements from said data...graphing means for generating a first graphical representation and further producing a second graphical representation” wherein the first graphical representation and a second graphical representation are simultaneously displayed on the means for displaying. It is respectfully submitted that Gurne et al. does not teach the features as recited in claim 17. For instance, the graphing capabilities of Gurne et al. do not teach the graphing means for generating and simultaneously displaying a first graphical representation and a second graphical representation as recited in claim 17 of the present invention. Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P Gurne et al. cannot be said to anticipate the present invention as claimed. Thus, withdrawal of the rejection is respectfully requested.

Claims 18-20 ultimately depend from independent claim 17 and are patentable over the cited prior art for at least the same reasons as is claim 17.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gurne et al. Claim 14 depends from independent claim 12 which is patentable over Gurne et al. for the reasons listed above. The Examiner has failed to rely on an additional reference to cure the deficiencies of Gurne et al. Thus, if a rejection on this basis is maintained, it is respectfully requested that the Examiner provide a reference or elaboration in support of the rejection.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Since Gurne et al. does not teach the invention as claimed, Gurne et al. can not be said to teach or suggest the present invention as recited in claim 14. Hence, withdrawal of the rejection is respectfully requested.

Newly added claim 21 recites, *inter alia*, a method of displaying automotive service data on a diagnostic tool including “displaying a first graphical representation...producing a second graphical representation...and simultaneously displaying the first graphical representation and the second graphical representation.” It is respectfully submitted that Gurne et al. does not teach the combined features as recited in claim 21.

Newly added claim 22 depends from independent claim 12 and is patentable over the cited prior art for at least the same reasons as is claim 12.

Conclusion

In view of the foregoing remarks, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned Patent Agent at (202) 861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a long horizontal flourish extending to the right.

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